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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,406	04/08/2005	Georg Frohlich	P04,0353	6881
26574	7590	01/12/2007		
SCHIFF HARDIN, LLP PATENT DEPARTMENT 6600 SEARS TOWER CHICAGO, IL 60606-6473			EXAMINER MAI, THIEN T	
			ART UNIT	PAPER NUMBER
			2876	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/12/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/507,406	Applicant(s) FROHLICH ET AL.	
	Examiner Thien T. Mai	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 51-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Acknowledgements***

Applicant's amendment filed on 11/03/2006 is hereby acknowledged. Claims 51-78 are newly added; claims 1-50 are cancelled

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/03/2006 has been entered.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim(s) 51, 56-69, 71-76, 78 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohberger et al. (20030063139) in view of Grosse et al. (20020054940)

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Hohberger discloses a method for production of a printed document with a unique identifier, comprising the steps of:

providing a file (par 110-111 discusses the member files in card member database 314) with information to be printed on the printed document;

providing on a recording medium a transponder (paragraphs 0110-111), said transponder being capable of being electronically read without contact (paragraph 0009), and

printing said information from said file onto said recording medium to create said printed document (Fig. 19 shows a post card printing process); reading said unique identifier (paragraph 102 mentions a prospect having unique identification; Fig. 18 and paragraph 106 discusses a card number uniquely identifying the customer on the printed document) from said transponder after said printing (paragraph 0106, 121) and

linking said unique identifier read from said transponder in said file with said information printed on said recording medium forming said printed document (paragraph 0122 mentions on-demand printing on the transponder that is tied to the target and the stored information; the target being the target address and customer information 206 in Fig. 17A and 250 in Fig. 18; see also paragraph 0102).

Hohberger is silent with respect to said unique identifier being stored in unchangeable fashion in an electronic storage region of said transponder;

Grosse et al. discloses an identification is identified through different indicia including read-only RFID 12, barcode 22, and/or numeric representation 14 on a

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recording medium (Fig. 1-3, paragraph 0025, 0044). The identification is linked to information stored in a database file (abstract)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Grosse et al. to prevent the data stored in the RFID from being altered inadvertently and to use the barcode as a backup means for accessing the identifier and related information in case the RFID reader is unavailable or the RFID components are permanently damaged

Re claim 61, Hohberger discloses a method of claim 51 wherein the unchangeable identifier refers to goods and said information printed on the recording medium refers to said goods (paragraphs 0002-0003 describes the invention is applied to media including shipping document, which inherently known in the art for having at least information associated with goods printed on the documents).

Re claim 62, Hohberger discloses a method of claim 51 wherein said unchangeable identifier is stored in an encrypted fashion in the transponder (paragraphs 0009, 11, 35, 36, 61, 82, 111, 128, 130 mentions RFID being encoded)

Re claim 63, Hohberger discloses a method of claim 51 wherein said printing of said information on said recording medium is by use of an electrophotographic, print device (claim 60).

Re claim 64, Hohberger discloses a method of claim 51 wherein said transponder is capable of being electronically written without contact (paragraph 52 describes shown in FIG. 5, printer 48 includes utilizes an RF signal 108 that is emitted

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by transponder programmer antenna 110 to program the memory in RFID integrated circuit 44)

3. Claim(s) 52-53, 70, 77 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohberger et al. (20030063139) modified by Grosse et al. (20020054940) further in view of Funk et al. (US 6,269,169)

Hohberger/Grosse discloses all limitations, as set forth in the claim(s) and discussed above, except

Hohberger/Grosse is silent with respect to file is used to check validity of the document wherein the information printed on the document is checked against the unique identifier read from the transponder and the file is used to check a printing error in the document.

Funk et al. disclose magnetic or RFID (col. 1 lines 30-40) printed document in FIG. 1 is shown a block diagram of the novel secure document reader verifier 10. Reader verifier 10 has a slot or opening 12 therein into which at least a portion of a document 11 is inserted. The size and shape of opening 12 may be changed to accommodate different types of identification documents and documents of value. An example of such a document 11 is a passport, on the inside of which is located a photograph, bibliographic and possibly other information about the bearer of the passport. This information includes passport number, issuance and expiration dates, issuing authority, biometric information about the person to whom the passport 11 is issued, and other information. (col. 3 lines 34-45).

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The novel document reader verifier disclosed herein can also read photographic and other information, which may include encoded biometric information of fingerprints, voice prints, and eyeprints, recorded on a passport or other document, and then compare these to information stored in data bases or to the bearer of the passport or other document. Such biometric information can be encrypted and stored in two dimensional bar codes on identity documents. The novel document reader verifier can compare in real time such biometric information recorded on a passport or other document with the output of readers, such as fingerprint and eye readers separate from but connected to the novel reader verifier described and claimed herein, taken at the time when a passport or other document is being read and verified to authenticate that the document is being carried or presented by the person to whom it was issued (col. 2 lines 39-55)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Funk et al. in order to ensure the data printed and encoded on the document are correct data, thus preventing unscrupulous individual from stealing the data for profits or stealing of identity when it is sent to the individual.

4. Claim(s) 54-55 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohberger et al. (20030063139) modified by Grosse et al. (20020054940) further in view of Veitch (7,091,864)

Hohberger/Grosse discloses all limitations, as set forth in the claim(s) and discussed above, except

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Hohberger/Grosse does not disclose additional data is written to the transponder in addition to the identifier

**Veitch** et al. discloses an RFID tag having a memory structure which allows for large amounts of information to be stored thereon. The memory structure can be arranged such that parts of the memory are read-only (that is unchangeable), other parts are read/write and further parts are encrypted and password protectable (col. 1 lines 55-65)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Veitch to those of Hohberger in order for the information stored in the RFID memory to be retrieved, in case the RFID memory's re-writable portion is inadvertently altered or erased, from a different database that has the same information stored on the RFID memory

#### ***Remarks***

Applicant's arguments filed 11/03/2006 have been fully considered but they are not persuasive.

In response to Applicant's arguments with respect to Hohberger

"In Hohberger a file known as a member data base at 314 in Fig. 19 is provided where information associated with a card member is printed on a card and that information is linked with card member information also written on the transponder. As shown in the flow chart of Fig. 15, if an RFID is used in the label, the RFID is programmed with step 160 and then the label is printed at step 181. As shown at Fig. 19, the data base 314 contains the information which 19 is to be



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programmed into the RFID and also printed, Significantly, from Figs. 15 and also the disclosure at column 9, paragraph 0111, it is clear that Hohberger is not teaching a reading of a unique identifier from the transponder after printing the information on the recording medium and then linking that read unique identifier to the information previously printed. To the contrary, in Fig. 15, Hohberger merely discloses a programming of the RFID and to print with the appropriate data taken from the storage 314, but there is no reading after the printing and then linking the read unique unchangeable identifier in the file with the information previously printed before the reading. Therefore claim 51 readily distinguishes."

It is respectfully submitted that Hohberger discloses the steps of printing said information from said file onto said recording medium to create said printed document (Fig. 19 shows a post card printing process); reading said unique identifier (paragraph 102 mentions a prospect having unique identification; Fig. 18 and paragraph 106 discusses a card number uniquely identifying the customer on the printed document) from said transponder after said printing (paragraph 0106, 121) and linking said unique identifier read from said transponder in said file with said information printed on said recording medium forming said printed document (paragraph 0122 mentions on-demand printing on the transponder that is tied to the target and the stored information; the target being the target address and customer information 206 in Fig. 17A and 250 in Fig. 18; see also paragraph 0102).

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5. In response to applicant's argument that Pagnol is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Pagnol teaches that the RFID's such as those used in Hohberger is known to be made to be read-only or unchangeable, in other words. This Office Action uses Grosse et al. in place of Pagnol since it also teaches barcode as discussed above.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien T. Mai whose telephone number is 571-272-8283. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thien T Mai  
Examiner  
Art Unit 2876

TM

January 07



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